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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,395	08/27/2003	Alexander G. Lastovich	P-5370	6084

26253 7590 10/05/2006

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EXAMINER

STIGELL, THEODORE J

ART UNIT PAPER NUMBER

3763

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NIT

Office Action Summary	Application No.	Applicant(s)	
	10/649,395	LASTOVICH ET AL.	
	Examiner	Art Unit	
	Theodore J. Stigell	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 3-6, 10, 12-17 and 19-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7-9, 11 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/10/04, 3/27/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species B in the reply filed on 9/25/2006 is acknowledged. The traversal is on the ground(s) that examination of claims 1, 9, 19, and 22 in view of all the embodiments would not induce an undue burden on the examiner for examination. This is not found persuasive because the different species have such different structures that the examiner would be required to search in many different subclasses and do a specific text search for each embodiment.

The requirement is still deemed proper and is therefore made FINAL.

The examiner agrees with the Applicant that claims 1-2, 7-9, 11, and 18 read on Species B and therefore these claims will be examined in the instant Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 9, 11, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Min (5,618,295). Min discloses an abrader device for delivering a substance into skin via an abrasion process the device comprising a base (50) having a top surface and a bottom surface onto which an abrader surface with microprotrusions (48) is mounted, the microprotrusions having at least one scraping edge for forming a furrow along a length of the skin, a handle (16) projecting from the top surface of the

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base, and means (12, 13,18) for controlling the amount of force or pressure applied to the microprotrusions as the abrader surface moves across the skin thereby forming furrows of a substantially consistent depth, wherein the microprotrusions are of a depth of about 5 to about 250 microns.

In regards to claims 9, 11, and 18, Min discloses an abrader device for delivering a substance into skin via an abrasion process, the abrader device comprising a housing (10) adapted to be pressed against the skin at a desired delivery site, the housing having a top with an upper opening (where 14 is located) and a bottom defining a lower opening which surrounds the delivery site, an applicator head (50) disposed in the upper opening and movable across the lower opening to abrade the delivery site, and an abrader surface (48) attached to the applicator head whereby the housing remains firm and stationary at the delivery site and structure of the housing and applicator head controls parameters of the abrasion process, wherein the housing has a bottom edge that defines the lower opening, surrounds the skin at the delivery site and provides tension to the skin thereby promoting uniform skin abrasion, wherein the housing is adapted be fixedly attached to the delivery site of the skin.

Claims 1, 7, 9, 11, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Jang (5,843,114). Jang discloses an abrader device for delivering a substance into skin via an abrasion process the device comprising a base (343) having a top surface and a bottom surface onto which an abrader surface with microprotrusions (301) is mounted, the microprotrusions having at least one scraping edge for forming a furrow along a length of the skin, a handle (340) projecting from the top surface of the

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base, and means (322) for controlling the amount of force or pressure applied to the microprotrusions as the abrader surface moves across the skin thereby forming furrows of a substantially consistent depth, wherein the microprotrusions are of a depth of about 5 to about 250 microns.

In regards to claims 9, 11, and 18, Jang discloses an abrader device for delivering a substance into skin via an abrasion process, the abrader device comprising a housing (330) adapted to be pressed against the skin at a desired delivery site, the housing having a top with an upper opening (337) and a bottom defining a lower opening which surrounds the delivery site, an applicator head (343) disposed in the upper opening and movable across the lower opening to abrade the delivery site, and an abrader surface (301) attached to the applicator head whereby the housing remains firm and stationary at the delivery site and structure of the housing and applicator head controls parameters of the abrasion process, wherein the housing has a bottom edge that defines the lower opening, surrounds the skin at the delivery site and provides tension to the skin thereby promoting uniform skin abrasion, wherein the housing is adapted be fixedly attached to the delivery site of the skin.

Claims 1-2, 7-9, 11, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrison (2,542,828). Morrison discloses an abrader device for delivering a substance into skin via an abrasion process, the abrader device comprising a base (22) having a top surface and a bottom surface (26) onto which an abrader surface (25) with microprotrusions are mounted, the microprotrusions having at least one scraping edge for forming a furrow along a length of skin, a handle (10) projecting

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from the top surface of the base, and means (27) for controlling the amount of force or pressure applied to the microprotrusions as the abrader surface moves across the skin forming a furrow of substantially consistent depth, further comprising a housing (11) surrounding the base, wherein the handle is a push button that collapses inside the base when activated, and the base rotates with respect to the housing and proportionally to the push button collapse causing the abrader surface to rotate against the skin, wherein the microprotrusions are of a depth of about 5 to 250 microns, wherein the means for controlling is a spring and further comprising a detent (29).

In regards to claims 9, 11, and 18, Morrison discloses an abrader device for delivering a substance into skin via an abrasion process, the abrader device comprising a housing (11) adapted to be pressed against the skin at a desired delivery site, the housing having a top with an upper opening and a bottom defining a lower opening which surrounds the delivery site, an applicator head (23) disposed in the upper opening and movable across the lower opening to abrade the delivery site, and an abrader surface (25) attached to the applicator head whereby the housing remains firm and stationary at the delivery site and structure of the housing and applicator head controls parameters of the abrasion process, wherein the housing has a bottom edge that defines the lower opening, surrounds the skin at the delivery site and provides tension to the skin thereby promoting uniform skin abrasion, wherein the housing is adapted be fixedly attached to the delivery site of the skin.

Conclusion


It is the examiner's position that the applicant has invoked 112-6th paragraph, means-plus-function language in claim 1. If this is not the intention of the applicant, appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Stigell whose telephone number is 571-272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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